**REMARKS**

This Amendment is submitted in response to the Office Action dated October 12, 2005. In the Office Action, the Patent Office rejected Claims 1-20 under 35 U.S.C. §103(a) as being unpatentable over the Business Wire article "*Specialty Care Network Announces Internet Strategy; New HealthGrades.com Site to Office Provider and Health Plan Rating Information*," June 30, 1999, Business Wire, p. 1519 (hereinafter "*HealthGrades*") in view of Applicant's admissions in the "Background of the Specification" section of the Specification.

By the present Amendment, Applicant amended Claims 1, 6-8, 10-12, 14-16 and 18-20. Applicant asserts that the amendments to the claims and the remarks that follow overcome the rejection made by the Patent Office and place the application in condition for allowance. Notice to that effect is requested.

In the Office Action, the Patent Office rejected Claims 1 -20 under 35 U.S.C. §103(a) as being unpatentable over *HealthGrades* in view of Applicant's admissions in the "Background of the Spefication". More specifically, the Patent Office asserts that:

> As per claim 1, *HealthGrades* teaches a method for matching medical condition information with a medical resource, the method comprising the steps of:
> searching the database for the information wherein the search or request is based on the query or search request input into the database and further wherein the search discloses a medical resource that treats the medical condition queried; Examiner interprets *HealthGrades'* teaching of providing a web site where "consumers find objective data regarding the best

hospital and physicians to treat their illness," (*HealthGrades*, paragraph 5), as reading on this limitation.

Although *HealthGrades* teaches "applying complex and proprietary Company-developed algorithms to collected provider data" (*HealthGrades*, paragraph 3), *HealthGrades* fails to explicitly disclose:

providing a database on the remote server wherein the database stores information relating to a plurality of medical conditions.

However, the above features are well-known in the art, as evidenced by Applicant's own disclosure.

In particular, Applicant's specification teaches"...generally known to provide information on a computer network ...[...]... allow an individual to access a database...[that]... may contain the information in an organized manner so that an individual on a remote computer may access the website and search the database for particular information" (see Specification, page 1, lines 21-30) and "it is generally known to provide access to databases that may contain medical information" (see Specification, page 2, lines 3-13).

System claims 15-20 repeat the subject matter of claims 1-4, 6, and 9, respectively, as a set of elements rather than a series of steps. As the underlying processes of claims 1-4, 6, and 9 have been shown to be fully disclosed by the teachings of *HealthGrades* in the above rejection of claims 1-4, 6, and 9, it is readily apparent that the system disclosed by *HealthGrades* includes the apparatus to perform these functions. As such, these limitations are rejected for the same reasons given above for method claims 1-4, 6, and 9, and incorporated herein.

Independent Claim 1, as amended, requires a method for matching medical condition information with a medical resource having the step of providing a database on the remote server wherein the database stores first information relating to a plurality of medical conditions and second information relating to a plurality of medical resources. Further, Claim 1 requires that the plurality of medical conditions are diseases and disorders and

the plurality of medical resources are medical specialists, specialty hospitals, medical facilities and health facilities which treat at least one of the plurality of medical conditions. Still further, Claim 1 requires the step of searching the first information and the second information in the database based on the query input into the website wherein the medical condition of the query is matched to a second medical condition from the plurality of medical resources in the first information wherein a medical resource from the plurality of medical resources in the second information is matched to the medical condition of the query wherein the medical condition of the query is treatable by the medical resource. Moreover, Claim 1 requires the step of displaying third information via the individual remote computer wherein the third information relates to the second medical condition and further wherein the third information relates to the medical resource which matches the medical condition of the query.

Independent Claim 15, as amended, requires a system for matching a medical condition with a medical resource having a database connected to the remote server wherein the database stores first information relating to a plurality of medical conditions and a plurality of medical resources wherein the plurality of medical conditions are diseases and disorders and further wherein the plurality of medical resources are medical specialists, specialty hospitals, medical facilities and health facilities which treat at

least one of the plurality of medical conditions. Further, Claim 15 requires means for disclosing second information wherein the second information relates to one of the plurality of medical conditions of the query. Moreover, Claim 15 requires means for contacting the medical resource on the website wherein the medical resource is contactable from the website via the means for contacting the medical resource.

*HealthGrades* merely teaches that HealthGrades.com intends to be the leading web-based site for the distribution of free health care provider and health plan rating information. Further, *HealthGrades* teaches that HealthGrades.com is designed to provide straightforward and objective educational quality ratings in the form of "report card" information. The information will be based on conclusions derived from applying complex and proprietary company-developed algorithms to collected provider data.

Contrary to the assertions of the Patent Office, Applicant's admissions in the "Background of the Specification" merely disclose deficiencies and problems in the art which are addressed by the present invention. The deficiencies and problems in the art as set forth in the Background of the Specification are overcome by the present invention.

Neither *HealthGrades* nor Applicant's admissions in the "Background of the Specification", taken singly or in combination, teaches or suggests the step of providing a database on the remote

server wherein the database stores first information relating to a plurality of medical conditions and second information relating to a plurality of medical resources wherein the plurality of medical conditions are diseases and disorders and further wherein the plurality of medical resources are medical specialists, specialty hospitals, medical facilities and health facilities which treat at least one of the plurality of medical conditions as required by Claim 1. Further, neither *HealthGrades* nor Applicant's admissions in the "Background of the Specification", taken singly or in combination, teaches or suggests the step of searching the first information and the second information in the database based on the query input into the website wherein the medical condition of the query is matched to a second medical condition from the plurality of medical resources in the first information as required by Claim 1. Further, neither *HealthGrades* nor Applicant's admissions in the "Background of the Specification", taken singly or in combination, teaches or suggests that a medical resource from the plurality of medical resources in the second information is matched to the medical condition of the query wherein the medical condition of the query is treatable by the medical resource as required by Claim 1. Moreover, neither *HealthGrades* nor Applicant's admissions in the "Background of the Specification", taken singly or in combination, teaches or suggests the step of displaying third information via the individual remote computer wherein the third information

relates to the second medical condition and further wherein the third information relates to the medical resource which matches the medical condition of the query as required by Claim 1.

Neither *HealthGrades* nor Applicant's admissions in the "Background of the Specification", taken singly or in combination, teaches or suggests a database connected to the remote server wherein the database stores first information relating to a plurality of medical conditions and a plurality of medical resources wherein the plurality of medical conditions are diseases and disorders and further wherein the plurality of medical resources are medical specialists, specialty hospitals, medical facilities and health facilities which treat at least one of the plurality of medical conditions as required by Claim 15. Further, neither *HealthGrades* nor Applicant's admissions in the "Background of the Specification", taken singly or in combination, teaches or suggests means for disclosing second information wherein the second information relates to one of the plurality of medical conditions of the query as required by Claim 15. Moreover, neither *HealthGrades* nor Applicant's admissions in the "Background of the Specification", taken singly or in combination, teaches or suggests means for contacting the medical resource on the website wherein the medical resource is contactable from the website via the means for contacting the medical resource as required by Claim 15.

On the contrary, *HealthGrades* merely teaches that "we intend to make HealthGrades.com the leading web-based site for the distribution of free health care provider and health plan rating information." Further, *HealthGrades* teaches that "HealthGrades.com, is designed to provide straightforward and objective educational quality ratings in the form of "report card" information." Still further, *HealthGrades* teaches "many sites provide information on the former, but only HealthGrades.com will provide information on the latter." Moreover, *HealthGrades* teaches "HealthGrades.com, Inc. currently offers Hospital Report Cards (at www.healthcarereportcards.com), which rates virtually every U.S. hospital based on specific performance in the areas of cardiac, orthopaedic, neuroscience, pulmonary/respiratory and vascular care.

As set forth above, the Patent Office asserts in the Office Action that the Examiner interprets *HealthGrades'* teaching of providing a web site where "consumers find objective data regarding the best hospital and physicians to treat their illness" as reading on the step of searching the database for information wherein the search or request is based on the query or search request input into the database and further wherein the search discloses a medical resource that treats the medical condition. However, Applicant asserts that the interpretation of *HealthGrades* by the Examiner is incorrect in view of paragraph 5 of *HealthGrades* which states "HealthGrades.com will include two new report card products

for physicians and health plans, as well as an expanded version of its Hospital Report Card product that includes obstetrics and pediatrics." Further, as set forth above, *HealthGrades* teaches that "HealthGrades.com, Inc. currently offers Hospital Report Cards (at www.healthcarereportcards.com), which rates virtually every U.S. hospital based on specific performance in the areas of cardiac, orthopaedic, neuroscience, pulmonary/respiratory and vascular care." Accordingly, Applicant asserts that *HealthGrades* teaches that the "objective data regarding the best hospitals and physicians to treat their illness" is merely the Hospital Report Cards which are based on specific performances in the areas of cardiac, orthopaedic, neuroscience, pulmonary/respiratory, vascular care, obstetrics and pediatrics.

Applicant's admissions in the "Background of the Specification" merely disclose the deficiencies and the problems in the art prior to the present invention. Nowhere does Applicant's admission in the "Background of the Specification" disclose the novel steps and structural elements as required by Claims 1 and 15, respectively. Therefore, neither *HealthGrades* nor Applicant's admissions in the "Background of the Specification", taken singly or in combination, teaches or suggests the novel steps of the method for matching medical condition information with a medical resource as required by Claim 1. Moreover, neither *HealthGrades* nor Applicant's admissions in the "Background of the

Specification", taken singly or in combination, teaches or suggests structural elements of the system for matching a medical condition with a medical resource as required by Claim 15.

Further, Applicant asserts that one of ordinary skill in the art at the time of Applicant's invention would never have been motivated to combine *HealthGrades* with Applicant's admissions in the "Background of the Specification" in the manner suggested by the Patent Office in formulating the rejections under 35 U.S.C. §103(a). As set forth above, Applicant's admissions in the "Background of the Specification" merely disclose the deficiencies and the problems in the art prior to the present invention. It is submitted that the question under §103 is whether the totality of the art would collectively suggest the claimed invention to one of ordinary skill in this art. In re Simon, 461 F.2d 1387, 174 USPQ 114 (CCPA 1972).

That elements, even distinguishing elements, are disclosed in the art is alone insufficient. It is common to find elements somewhere in the art. Moreover, most if not all elements perform their ordained and expected functions. The test is whether the invention as a whole, in light of the teachings of the references in their entireties, would have been obvious to one of ordinary skill in the art at the time the invention was made. Connell v. Sears, Roebuck & Co., 722 F.2d 1542, 220 USPQ 193 (Fed. Cir. 1983).

It is insufficient that the art disclosed components of Applicant's invention, either separately or used in other

combinations. A teaching, suggestion, or incentive must exist to make the combination made by Applicant. Interconnect Planning Corp. v. Feil, 774 F.2d 1132, 1143, 227 USPQ 543, 551 (Fed. Cir. 1988).

With the analysis of the deficiencies of *HealthGrades* and Applicant's admissions in the "Background of the Spefication" in mind, as enumerated above, no reason or suggestion in the evidence of record exists why one of ordinary skill in the art would have been led to modify *HealthGrades* with the deficiencies and problems in the art as set forth in Applicant's admissions in the "Background of the Spefication" to produce the claimed invention. Therefore, *prima facie* obviousness has not been established by the Patent Office as required under 35 U.S.C. §103.

Even assuming that one having ordinary skill in the art could somehow have combined the references applied by the Patent Office, the references still lack the novel step and the structural element positively recited in Claims 1 and 15, respectively.

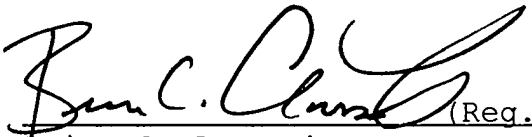
In view of the foregoing remarks and amendments, Applicant respectfully submits that the rejection of Claims 1-20 under 35 U.S.C. §103(a) has been overcome and should be withdrawn. Notice to that effect is requested.

Claims 2-14 depend from Claim 1; and Claims 16-20 depend from Claim 15. These claims are further believed allowable over the references of record since each sets forth an additional structural

element and a novel step of Applicant's method and system, respectively.

In view of the foregoing remarks and arguments, Applicant respectfully submits that all of the claims in the application are in allowable form and that the application is in condition for allowance. If, however, any outstanding issues remain, Applicant urges the Patent Office to telephone Applicant's attorney so that the same may be resolved and the application expedited to issue. Applicant requests the Patent Office to indicate all claims as allowable and to pass the application to issue.

Respectfully submitted,



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**CERTIFICATE OF MAILING**

I hereby certify that this **Amendment** and **Return Receipt Postcard** are being deposited with the United States Postal Service as First Class Mail in an envelope addressed to: Mail Stop Amendment, Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450 on January 12, 2006.

Brian C. Anscomb (Reg. No. 48,641)